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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,432	11/16/2007	Zhongxin Ge	1034136-000035	2929
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EXAMINER MCCRACKEN, DANIEL				
ART UNIT		PAPER NUMBER		
1736				
NOTIFICATION DATE		DELIVERY MODE		
04/19/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com
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Office Action Summary

Application No.

10/594,432

Applicant(s)

GE ET AL.

Examiner

DANIEL C. MCCracken

Art Unit

1736

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4 and 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Citation to the Specification will be in the following format: (S. # : ¶/L) where # denotes the page number and ¶/L denotes the paragraph number or line number. Citation to patent literature will be in the form (Inventor # : LL) where # is the column number and LL is the line number. Citation to the pre-grant publication literature will be in the following format (Inventor # : ¶) where # denotes the page number and ¶ denotes the paragraph number.

Status of Application

The response dated 3/30/2011 has been received and will be entered. Claims 2-4 and 7-16 are pending. Claim 7 is currently amended. Claims 1, 5-6 and 17-20 are acknowledged as cancelled.

The prior indication of allowable subject matter is withdrawn in light of newly discovered prior art. On additional reconsideration, certain issues were noted with respect to Claim 7 and the groups recited therein. An additional rejection under 35 U.S.C. 112 appears *infra*.

Response to Arguments

Claim Rejections – 35 U.S.C. §112

I. With respect to the rejection of Claims 7-16 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, this rejection is **WITHDRAWN** in light of the amendment deleting “a protective group.”

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites “Q” and states that “Q is o-methyl.” Dependent Claim 9 states that Q is a methoxy group. While the same language appears in the specification - see e.g. (S. 7: 8 et seq.) - it is unclear whether “o-methyl” was a typographical error for “O-methyl” (denoting an oxygen bonded to a methyl group or a “methoxy group”) or whether this refers to “ortho-methyl,” i.e. there is a benzene ring bound to the PEG, with a methyl group “ortho” to the PEG. All dependent claims not specifically addressed import the issues associated with Claim 7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

I. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,538,153 to Hirsch, et al. in view of (i) US 6,471,942 to Miller, et al., (2) Tabata, et al., Biological functions of fullerene, Pure Appl. Chem. 1999; 71(11): 2047-2053 (hereinafter "Tabata at __").

With respect to Claims 2-4, Hirsch teaches fullerenes functionalized with the product of malonyl and glycol moieties. See (Hirsch 2: 40 et seq., 4: 56 et seq. – teaching glycols). To the extent Hirsch may not teach ethylene glycol, this is an obvious expedient. Polyethylene glycol moieties are useful in fullerene chemistry as facilitating dispersal or solubility, and the Examiner takes official notice that they are. In support of taking official notice, i.e. in making sure there is substantial evidence on the record, the Examiner provides Miller and Tabata. See (Miller 3: 14-31) and (Tabata at 2048) ("Poly(ethylene glycol) (PEG) was selected as the water-soluble polymer for C₆₀ conjugation because it has been widely used for chemical modification of drugs

due to simple conjugation chemistry.”). Note that Hirsch too identifies drug delivery/pharmaceuticals as a use for the fullerenes therein, so there is motivation in Hirsch to use moieties that facilitate solubility. See e.g. (Hirsch 1: 41 et seq.). Note that various (e.g. ethyl) malonyl groups are suggested. (Hirsch 2: 36 et seq.). Finally, to the extent Hirsch doesn’t teach the trimetallic nitride endohedral metallofullerenes, these – and the hydroxyl groups – are taught by Miller as well. See (Miller 2: 49-49; 3: 20-25). The combination would appear to reflect application of known malonate chemistry (Hirsch) to known fullerenes (Miller) in a predictable manner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL C. MCCracken whose telephone number is (571)272-6537. The examiner can normally be reached on Monday through Friday, 9 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Stanley S. Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel C. McCracken/
Daniel C. McCracken
Primary Examiner, Art Unit 1736
DCM

